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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 13
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pacific Telecard

Serial No. 75/845,318

James C. Wray, Esq. for Pacific Telecard.

Ellen J.G. Perkins, Trademark Examining Attorney, Law
Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Hairston, Chapman and Rogers, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On November 30, 1999, Pacific Telecard (a Hawaii corporation) filed an application to register on the Principal Register the mark PACIFIC PHONE CARD for "telephone calling cards, not magnetically encoded" in International Class 16. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce. In response to a requirement of the Examining Attorney, applicant disclaimed the words "phone card."

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the five previously registered marks listed below, all issued to Pacific Telesis Group (a Nevada corporation):

(1) Registration No. 1,475,336, issued February 2, 1988 (Section 8 accepted, Section 15 acknowledged), for the mark PACIFIC TELEPHONE for "telephone communication services and consulting services in the telecommunications field" in International Class 38, (the word "telephone" is disclaimed), with claimed first use of December 31, 1906;

(2) Registration No. 2,145,463, issued March 17, 1998, for the mark PACIFIC BELL WORLDWIDE CALLING CARD for "telephone calling card services" in International Class 36, (the words "worldwide calling card" are disclaimed), with claimed first use of November 1996;

(3) Registration No. 2,151,430, issued April 14, 1998, for the mark PACIFIC BELL BUSINESS ONE NUMBER CARD for "telephone calling card services" in International Class 36, (the words "business" and "card" are disclaimed), with claimed first use of November 1996;

(4) Registration No. 2,151,432, issued April 14, 1998, for the mark PACIFIC BELL ONE NUMBER CALLING CARD for "telephone calling card services" in International Class

36, (the words "calling card" are disclaimed), with claimed first use of November 1996; and

(5) Registration No. 2,198,900, issued October 20, 1998, for the mark PACIFIC BELL WORLDWIDE BUSINESS CALLING CARD for "telephone calling card services" in International Class 36, (the words "worldwide business calling card" are disclaimed), with claimed first use of December 1, 1996.

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested.

We affirm the refusal to register. In reaching this conclusion, we have considered all of the relevant du Pont¹ factors.

We turn first to a consideration of applicant's goods and registrant's services. It is well settled that goods and/or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and/or services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to

¹ In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods and/or services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Confusion in trade can occur from the use of similar marks for products on the one hand and for services involving those products on the other hand. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *Safety-Klean Corporation v. Dresser Industries, Inc.*, 518 F.2d 1399, 186 USPQ 476 (CCPA 1975); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988); and *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983).

Of course, it has been repeatedly held that in determining the registrability of a mark, this Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration(s). See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, applicant's goods are identified as "telephone calling cards, not magnetically encoded," while registrant's services are identified as "telephone calling card services" and "telephone communication services and consulting services in the telecommunications field." The Examining Attorney submitted numerous third-party registrations, based on use in commerce, to show that a single source may provide telephone communication services, telephone calling card services, and telephone calling cards. In addition, the Examining Attorney submitted three excerpted stories retrieved from the Nexis database to show that three major telephone companies (AT&T, Sprint, and MCI) have expanded their services to include pre-paid calling cards. Clearly, telephone calling cards not magnetically coded are closely related to telephone calling card services and telephone communication services. See *American Paging Inc. v. American Mobilephone Inc.*, 13 USPQ2d 2036 (TTAB 1989), aff'd unpub'd, but appearing at 17 USPQ2d 1726 (Fed. Cir. 1990). That is, applicant's goods are commercially closely related to telephone calling card services and to telephone communication services. See *Permatex Company, Inc. v. California Tube Products, Inc.*, 175 USPQ 764 (TTAB 1972).

Applicant argues that the registrant's services are delivered by a telephone utility company located in San Francisco, California, and registrant bills customers for local and long distance services, whereas applicant's goods are prepaid cards "which are sold in drug store [sic], grocery stores and newsstands." (Applicant's July 3, 2001 Response, p. 3.) There is no restriction in either applicant's identification of goods or in any of registrant's identifications of services regarding customers and/or channels of trade. Thus, the Board must presume that these goods and services are offered through all normal channels of trade to all the usual purchasers.

Applicant also argues that the purchasers of both its calling cards and registrant's telephone services are "careful sophisticated person [sic] making careful, sophisticated decisions." (Applicant's Brief, p. 6.) We are not convinced, on this record, that the general public to whom these goods and services are offered are careful and sophisticated in these types of purchases. Even if the relevant purchasers are sophisticated, that does not mean that they are immune from confusion as to the source of the goods and services. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

We find that the involved goods and services are closely related, and could be sold to similar classes of purchasers, so that if sold or marketed under similar marks, confusion as to source by consumers would be likely.

Turning now to the marks, when analyzing applicant's mark and each of the registered marks, it is not improper to give more weight to a dominant feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987).

We consider first applicant's mark PACIFIC PHONE CARD and the cited registered mark PACIFIC TELEPHONE, both of which consist solely of typed words, the common word being PACIFIC, and each with disclaimers of the respective generic words, "phone card" in applicant's mark and "telephone" in registrant's mark. Thus, these two typed marks share the word PACIFIC as the source-indicating portion of each mark. Obviously, the connotation of PACIFIC is virtually the same for both applicant and registrant--i.e., their proximity to the Pacific Ocean, registrant being on the Pacific Coast of North America, and

applicant being in Hawaii and surrounded by the ocean. Likewise, each may evoke the secondary connotation of "pacific" as "tranquil" or "serene."² Moreover, the respective connotations of "telephone" and "phone card" are very similar and relate specifically and directly to telephones and making telephone calls.

When considered in their entirety, we find the marks PACIFIC TELEPHONE and PACIFIC PHONE CARD to be similar in sound, appearance, connotation and commercial impression. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

Next we consider applicant's mark PACIFIC PHONE CARD as compared to the other four cited marks -- PACIFIC BELL WORLDWIDE CALLING CARD, PACIFIC BELL WORLDWIDE BUSINESS CALLING CARD, PACIFIC BELL BUSINESS ONE NUMBER CARD, and PACIFIC BELL ONE NUMBER CALLING CARD. Here the four typed registered marks each begin with "PACIFIC BELL" followed by descriptive/generic wording and in two registrations, some lesser source-indicating wording. All of the additional words have been disclaimed except for the words "one number." The registrant owns the mark PACIFIC TELEPHONE for telephone communication services. Registrant's other

² The American Heritage Dictionary of which we take judicial notice. See TBMP §712.

four registrations begin with the words PACIFIC BELL, and the term "BELL" for telecommunication goods or services is evocative of "Ma Bell" or "Baby Bells." Thus, PACIFIC BELL connotes a telephone company.

The words PACIFIC or PACIFIC BELL in the respective marks are the portions which would be used in shorthand references to the respective goods and services; and are the portions most likely to be impressed in the memory of the purchaser and/or user of the goods and services, and to serve as the indicator of origin. The differences in the marks may not be recalled by purchasers or users seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; that is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

The descriptive/generic wording (e.g., "phone card," "calling card," "business," and/or "worldwide") hardly

serves to distinguish the marks in any meaningful way. Moreover, it is the first part of a mark which is most likely to be impressed upon the mind of a purchaser and be remembered by the purchaser. See *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Purchasers will likely remember PACIFIC and perhaps they may recall something to do with telephone calling cards from applicant's mark, and they will likely remember PACIFIC or PACIFIC BELL from the marks in these four cited registrations, along with perhaps something about telephone calling card services. That is, purchasers are unlikely to distinguish the marks based on the descriptive/generic additional wording, when the arbitrary initial word is identical in all of the marks.

Moreover, the likelihood of confusion may be enhanced by the ease with which applicant's telephone calling cards may be purchased, i.e., in a checkout line at a drug store or grocery store, or at a newsstand, a purchasing environment in which the purchaser may not engage in careful consideration of the source of applicant's cards.

Here again all of these four registered marks and applicant's mark all still connote something about PACIFIC -- the ocean, the area of the Pacific West and Hawaii, or "tranquil/serene." Whatever the connotation, it is

essentially the same for both applicant and registrant when used in relation to the involved goods and services. See *The Wella Corporation v. California Concept Corporation*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977).

With regard to the involved marks, applicant argues the following:

"[T]he word Pacific by itself has no trademark significance. It is the marks in their entirety that have trademark significance." (Applicant's October 20, 2000 Response, p. 1); and

"[I]f consumers have been able to distinguish between the cited registrations, then there could not possibly be added confusion by Applicant's mark. Further, the over usage of the mark PACIFIC adds to this. PACIFIC is a highly used word that is unregistrable by itself." Applicant's Brief, pp. 6-7).

We agree that marks must be considered in their entirety, but we do not agree that the word PACIFIC has no trademark significance. If that were the case, applicant would, in essence, be applying for an unregistrable mark in this case. Moreover, there is no need for the purchasing public to distinguish between the cited registrations (all PACIFIC/PACIFIC BELL marks for telephone services/telephone calling card services) because they are all owned by one single entity.

To whatever extent, if any, applicant meant that PACIFIC is a weak mark entitled to a narrow scope of protection due to the number and nature of similar marks in use for related goods and/or services, there is no evidence of record on this point. Applicant argued that "[T]he Hawaiian Telephone Directory which is a GTE Hawaiian Tel Directory has three and a half pages of listings of companies which start with the word Pacific. Pacific by itself is not a trademark." (Applicant's October 20, 2000 Response, p. 4.) However, applicant did not enclose photocopies or any other evidence supporting this statement. Moreover, in its brief on appeal (p. 7), applicant's statement was changed to "[f]our and one half pages of names starting with PACIFIC are found in the GTE Hawaiian Telephone Directory white pages...." Again no evidence in support of this argument was submitted.

Although each of the four cited registrations beginning with the words PACIFIC BELL include additional words, and more words than appear in applicant's mark, we are not persuaded that the purchasing public will pay close attention to the minor differences in the marks or that they will analyze the marks with specific and clear reference to these additional, and generally descriptive/generic words as suggested by applicant. See

Kangol Ltd. v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); and Chemical New York Corp. v. Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986).

The latter four cited marks and applicant's mark, when considered in their entirety, are similar in sound and connotation, creating a similar commercial impression.

Even if purchasers do specifically remember the differences in the involved word marks, they may believe that applicant's mark is simply a version of registrant's mark for a new product, (i.e., telephone calling cards), offered by registrant. See *In re Dixie Restaurants*, supra.

Applicant contends that there has been no actual confusion. Its argument on this du Pont factor is set forth as follows (brief, p. 7):

The Applicant's mark and the cited registrations have bee [sic] sued [sic] without any confusion. The Applicant's mark has been used since [?] without confusion with the cited mark [sic].

However, this argument is unavailing as applicant's application is based on a bona fide intention to use the mark in commerce; there is no information of record regarding if or when applicant commenced use of its mark; there is no information as to respective sales; and there is no input from the registrant. In any event, the test is

likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Suffice it to say that none of applicant's other arguments (e.g., that its mark has "distinctive alliteration") is persuasive of a different result herein.

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) is affirmed.